



123

AF  
3636

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Atty. Dkt. No. 039768-0101

Applicant: Sung-Soo KIM

Title: SEAT BELT WITH PRINTED FACE AND PRINTING  
METHOD THEREOF

Appl. No.: 09/783,392

Filing Date: February 15, 2001

Examiner: Peter R. Brown

Art Unit: 3636

Box AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

RECEIVED

APR 01 2004

GROUP 3600

REPLY BRIEF

Sir:

This Reply Brief is filed within two months of the Examiner's Answer dated Jan. 30, 2004 and is filed in triplicate under the provisions of 37 CFR § 1.192. Nevertheless, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

REPLY

In this Answer, the Examiner merely repeats his position with respect to the holding that the claimed invention is obvious and repeats his reliance on what he holds to be "inherent" and a "matter of design choice." The Examiner rebuts the arguments presented in the Appeal Brief by presenting nothing more than a slightly revised version of the rejection.

By this answer, the Examiner has confirmed that he has not established a *prima facie* case by, in addition to improperly using "inherency" in a rejection made under § 103 (inherency can only be applied under § 102), failing to meet his burden of showing that the indicia on the belt would (assuming *arguendo* that inherency can be applied), due to its nature, inherently prevent or lessen to some degree slippage out of the users grasp in each and every instance. That is to say, to advance an argument of "inherency" the Examiner is required to show that the property that is maintained to be "inherent" must not just happen in some cases but must happen in all cases. This argument has not been rebutted.

The Appellant has argued that some surfaces may promote slippage and has advanced reasons in support of this. The Examiner has failed respond to this position in addition failing to show that slippage will be prevented in each and every situation.

The issue of "design choice" is similarly defective in that the choice of material will effect the coefficient of friction of the belt surface and will go beyond the realm of design choice and have a definite functional effect on the physical properties of the belt and the manner in which it can be securely gripped by a user.

It was argued in the Appeal Brief that the subject matter of claims 2-7 and 9-10 was not addressed in the rejection. The Examiner has again failed to address this in this answer.

In the Appeal Brief it was pointed out that:

Claim 2 is patentable over the art for at least the reason that this claim calls for the printed face to be made of silicon rubber. Neither of the references to Cave or Miyamoto disclose the use of this type of rubber. In fact, Cave teaches toward the use of a pile material and therefore must be seen as teaching away from the claimed silicon rubber. It is submitted that a reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985).

Claim 3 is patentable over the art for at least the reason that the printed face is made of sol ink. Neither of Cave or Miyamoto disclose the use of this material and as

noted above, the pile of Cave would have to be seen as teaching away from this type of ink.

Claim 4 is patentable over the art in that it calls for the printed face to be formed with a multicolor printed pattern. There is no suggestion of this structure in Cave. The pile of Cave is not suggestive of a multicolor printed pattern. In Miyamoto the highly visible material is to be attached by stitching or chemical bonding (c.f. printing), to render the belt easily visible from outside of the vehicle and therefore focuses on portions of the belt which pass over shoulder and/or extend into clear view. This teaches away from a position which is apt to be grasped and toward one which is much higher on the belt. Miyamoto, on the other hand, is such as to disclose a "highly visible material." Just what this is meant to entail is not clear from the very brief disclosure carried in this document. However, there is no discussion of multicolor and nothing to suggest that a pattern should be formed of different colors.

Claim 5, as noted above, is patentable over the art applied in that it calls for the above mentioned silicon rubber to comprise 8~15 wt % of silicon oil, 2~10 wt % of epoxy silane, 0.5~1.0 wt % of amino silane, 0.1~0.4 wt % of platinum catalyst, 0.3~1.0 wt % of pigment, 1~8 wt % of calcium carbonate ( $\text{CaCO}_3$ ), 2~10 wt % of silica 200 mesh or 300 mesh, for a silicon liquid phase rubber 100 wt %. There is absolutely no disclosure of this type of formulation in either of Cave or Miyamoto and therefore no grounds for the rejection of this claim.

Claim 6 is patentable over the art in that it calls for the printed face to be formed by silk printing. Silk printing is neither disclosed nor suggested in either of Cave or Miyamoto.

It is submitted that in connection with the subject matter of this claim, as well as the other finally rejected claims, when levying an obviousness rejection under 35 U.S.C. 103, the Examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references teach or suggest all the claim limitations. See MPEP §2143 (Aug. 2001). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 7 is patentable over the art in that it calls for the printed face to be formed by a decalcomania. No suggestion of decalcomania is found in the art applied.

Claim 9 is patentable over the art in that it calls for the printed face to be formed with a multicolor printed pattern. This claim inherits all of the limitations of claims 1 and 3 is therefore patentable for at least the same reasons that the subject matter of these claims is patentable.

Claim 10 is patentable over the art in that it calls for a seat belt comprising: a band of woven polyester; and printed means for preventing slippage from the user's grip and to facilitate the putting on and taking off of the seat belt provided at location on the belt selected to be grasped by a user when fastening the seat belt. There is no disclosure of printed means for preventing slippage from the user's grip disclosed in either of Cave or Miyamoto.

The above issues have been improperly ignored. At the very least, these claims are allowable for at least the reasons advanced above.

Conclusion

It is again submitted that a *prima facie* cases of obviousness has not been established for any of the appealed claims. It is therefore again respectfully requested that these rejections be reversed, the pending claims be allowed and the application be passed to issue.

Respectfully submitted,

By 

Date March 30, 2004

FOLEY & LARDNER  
Customer Number: 22428  
Telephone: (202) 672-5490  
Facsimile: (202) 672-5399

Michael D. Kaminski  
Attorney for Applicant  
Registration No. 32,904

Keith J. Townsend  
Registration No. 40,358